

ESTTA Tracking number: **ESTTA362277**

Filing date: **08/10/2010**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

Proceeding	92052575
Party	Plaintiff Donald Mlynek
Correspondence Address	KENNETH LYNCH 6994 EL CAMINO REAL, #204 CARLSBAD, CA 92009 UNITED STATES lynchlaw@roadrunner.com
Submission	Other Motions/Papers
Filer's Name	Kenneth Lynch
Filer's e-mail	lynchlaw@roadrunner.com
Signature	/kenneth lynch/
Date	08/10/2010
Attachments	TTABCancellation.pdf (6 pages)(18759 bytes)

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Donald Mlynek

Plaintiff,

v.

Combat Medical Systems, LLC

Defendant.

Cancellation No. 92052575

PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO DISMISS

The defendant, Combat Medical Systems, LLC, has filed a Motion to Dismiss Cancellation No. 92052575 against plaintiff Donald Mlynek's Registered Trademark, Combat Medical LLC, Registration No.3780231. The defendant presents two arguments in the motion:

1. Cancellation should be dismissed because plaintiff is attempting to enforce an exclusive right to disclaimed elements of its registered mark;
2. Cancellation should be dismissed because plaintiff lacks standing.

Both of defendant's flawed arguments shall be addressed in this opposition.

STATEMENT OF FACTS

On April 1, 2009, plaintiff Donald Mlynek filed an application for the trademark, Combat Medical, LLC. Mr. Mlynek is a former special forces decorated Marine who sells medical bags that he designed himself. These bags are used on the front combat lines to save lives. The primary purchaser of these bags is the United States Government. On April 27, 2010, the Combat Medical, LLC mark was registered on the Principle Register [3780231].

On February 9, 2010, defendant Combat Medical Systems, LLC filed an application for the trademark, Combat Medical Systems, LLC. On June 15, 2010, defendant's Combat Medical Systems, LLC mark registered on the Supplemental Register as standard character with no logo..

Plaintiff Donald Mlynek soon noticed the striking similarities between the two marks:

Combat Medical, LLC [plaintiff's 4/27/10 registered mark] principle

Combat Medical Systems, LLC [defendant's 6/15/10 registered mark] supplemental

Both marks also operate in similar channels of trade or commerce through their selection of similar International Codes:

Combat Medical, LLC: [IC 010, medical bags sold empty]

Combat Medical Systems, LLC: [IC 035, ...combat casualty care medical goods...]

On June 16, 2010 plaintiff filed a Petition for Cancellation based on priority and likelihood of confusion.

ARGUMENT

Motions to dismiss are disfavored, as there exists "a powerful presumption against rejecting pleadings for failure to state a claim." Gilligan v. Jamco Dev. Corp., 108 F.3d 246, 249 (9th Cir. 1997) quoting Auster Oil and Gal, Inc. v. Stream, 764 F2d 381, (5th Cir. 1985). "a complaint should not be dismissed for failure to state a claim unless it appears beyond doubt that the plaintiff can prove no set of facts in support of his claim which would entitle him to relief." Conley v. Gibson, 335 U.S. 41, 45-46 (1957). Further, in considering a motion to dismiss, a district court or board must take as true all well-pleaded allegations of material fact and must construe them in the light most favorable to the plaintiff. Ileto v. Glock, Inc. 349 F.3d 1191, 1200 (9th Cir. 2003).

A. Plaintiff Has Standing to Bring a Cancellation Action

A party has standing to bring a cancellation if that party has a personal stake in the outcome of the case. Therefore, standing is a threshold inquiry directed solely to establish the interest of a party. Lipton Indus., Inc. v. Ralston Purina Co., 670 F.2d 1024, 1028-29, 213 USPQ 185, 189 CCCPA 1982).

The statutory provision governing standing in cancellation proceedings is found in Section 14 of the Lanham Act, which provides that a cancellation may be filed by any person, “who believes that he would be damaged by the registration of the mark”. 15 U.S.C. 1064. The Federal Circuit has further recognized two requirements for standing:

- (1) The plaintiff must have a real interest in the proceeding;
- (2) A reasonable basis for the belief in damage.

Ritchie v. Simpson, 170 F3d 1092, 1098, 50 USPQ2d 1023, 1027 (Fed. Cir. 1999).
TBMP 309.03(b); 37 CFR 2.111.

Here, Donald Mlynek is the owner of the Combat Medical, LLC registered mark [Principle Register]. Combat Medical, LLC has for many years designed, manufactured advertised and sold, mostly to the U.S. Government, combat medical bags. Mr. Mlynek has used his mark especially on combat medical bags at least as early as April 1, 2008. Mr. Mlynek files a petition for cancellation action against the Combat Medical Systems, LLC mark [Supplemental Register] on the basis of priority and confusion to protect his mark. Plaintiff Mlynek has a real interest in the proceeding since he owns the registered mark and is now defending it. Since both marks are used in similar channels of commerce with similar International Codes with similar products, Mr. Mlynek believes that he will be damaged by the defendant’s mark as a result of

confusion, mistake, deception and lost revenue from the sales of the defendant's merchandise.

B. A Trademark is More Than Disclaimed Words

The defendant argues that the plaintiff is asserting rights in disclaimed words of the trademark and cites Dena Corp v. Belvedere Int'l Inc. [misspelled as Dean Corp. v. Belvedere Int'l Inc.], 950 F2d 1555. The plaintiff disclaimed the words *combat medical* in its mark; the defendant disclaimed *medical systems* in its mark. The Dena case is less about disclaimed words in a mark and more about whether or not a mark in question was considered to be a unitary mark: "a unitary mark must create a single and distinct commercial impression" Dena v. Belvedere 950 F2d 1555, 1556. But if we follow the defendant's analysis of the Dena case, then the defendant would not have standing to assert a motion to dismiss since they are asserting rights in disclaimed words in its mark. But a mark is more than just its words.

A line of cases has held that disclaimed words in a mark play a very small role in determining, for example, in the Case of Combat Medical, LLC, whether or not similarity confusion would exist with Combat Medical Systems, LLC. American Throwing Co. v. Famous Bathrobe Co. (1957) 45 CCPA 737, 250 F2d 377, 116USPQ 156; Beaunit Mills, Inc. (1959) 47 CCPA 755, 274 F2d 436, 124 USPQ 370. Marks cannot be dissected for purposes of any comparison but must be considered in their entirety. Johnson and Johnson v. Veon Chemical Co. (1962) 49 CCPA 1052, 301 F2d 952, 133 USPQ 395.

Other cases have also held that disclaimed words do not have a significant impact on a similarity confusion analysis. In J. Greenebaum Tanning Co. v. Respro, Inc. (1938) 25 CCPA 899, 94 F2d 818, disclaimed words in the mark did not affect the issues of confusion. In another case that addressed likelihood of confusion between "Shanghai" and "Night in Shanghai", it was

not vitally important that “Shanghai” was disclaimed in one of the marks. Vi-Jon Laboratories v. Lentheric, Inc (1943) 30 CCPA 916, 133 F2d 947, 56 USPQ 586.

The defendant cites only one other case in its motion to dismiss: In Re Candy Bouquet 73 USPQ2d 1883 (TTAB 2004). This case addressed two issues : whether or not the service mark was generic and whether or not the mark acquired distinctiveness. The TTAB found that the mark is generic and may or may not acquire distinctiveness. This case appears to off point and does not really address the issues at hand.

Finally and interestingly, two cases that date back to almost the start of trademark case recordings, held that registrant’s who disclaimed words in their marks were entitled to prevent their mark’s appropriation by another. Warner-Patterson Co v. Malcomb (1935) 22 CCPA 1381, 77 F2d 950; Standard Water Systems v. Tripure Water Systems (1917) 124 Ms. Dec. 42, *Trademark Reporter*, Volume 7, NY, NY 1917.

CONCLUSION

In summary of the above analysis: (a) motions to dismiss are disfavored; (b) the plaintiff has standing; (c) disclaimed words in a trademark play a small role in determining confusing similarity. Based on this analysis, the Motion to Dismiss should be denied.

Date: 8/10/10

/s/kenneth lynch
Kenneth Lynch, Attorney for Donald Mlynek
California State Bar No. 182024
6994 El Camino Real, #204
Carlsbad, CA 92009
lynchlaw@roadruuner.com
(760)931-0030

Certificate of Service

The undersigned hereby certifies that a copy of **PLAINTIFF'S OPPOSITION TO DEFENDANT'S MOTION TO DISMISS** was electronically filed with the TTAB via the ESTTA Filing System with the same served upon all parties of record, at their email and mailing address by First Class mail on this date:

CHRISTOPHER SOREY ESQ
WYRICK ROBBINS YATES & PONTON, LLP
4101 LAKE BOONE TRAIL #300
RALEIGH NC 27607
ip@wyrick.com
(919) 781-4000

/s/kenneth lynch
Kenneth Lynch
Date: 8/10/10